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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,108	12/12/2003	Tomohiro Matsuda	CFA00023US	1918

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CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION
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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/735,108	Applicant(s) MATSUDA ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Examiner hereby requests a translation of the Chinese Office Action, as mentioned in page 3 of the Information Disclosure Statement of 14 November 2005, as it would greatly aid the Office in examination. This is the second request for the Chinese Office Action (note “Conclusion” section, action mailed 8 January 2008).
2. Examiner notes that Applicant did not challenge the Examiner’s citations of Official Notice in the previous Office Action. Therefore, the cited limitations in claims 6 and 10 are taken to be admitted prior art due to the failure to challenge the Examiner's assertions. See MPEP §2144.03 (C).
3. Claims 1-21 have been cancelled.
4. Claims 22-42 are pending.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

6. Claims 22-31 are objected to for usage of the functional language “configured to”. It is believed that Applicants intend "configured to" to mean “programmed to” since “configured to” is functional language and therefore given less patentable weight. In light of the notice function

of the claims, the Examiner respectfully requests changing “configured to” to “programmed to” where a positive recitation is desired.

7. Independent claim 22 notes that “when the...unit determines that the...data...does not include the first information and the second information”, the product is neither genuine nor counterfeit. However, it seems that the “product is a counterfeit product when...the product data...includes the first information and does not include the second information”. It seems that a product may be evaluated as counterfeit *and* neither genuine nor counterfeit, as a product containing the first information only can be said to “include the first information and...not...the second information”, as well as “not include the first information and the second information”. Based on the specification, the Examiner has interpreted this statement to mean “does not include the first information nor does it include the second information”. A similar change is recommended to the Applicants.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 22-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Independent claim 22 notes that “when the...unit determines that the...data...does not include the first information and the second information”, the product is neither genuine nor counterfeit. However, it seems that the “product is a

counterfeit product when...the product data...includes the first information and does not include the second information”. It seems that a product may be evaluated as counterfeit *and* neither genuine nor counterfeit, as a product containing the first information only can be said to “include the first information and...not...the second information”, as well as “not include the first information and the second information”. A person having ordinary skill in the art would find this to be unclear, wondering whether products containing neither of the two pieces of information would be recorded as counterfeit, or not counterfeit and not genuine. Based on the specification, the Examiner has interpreted this statement to mean “does not include the first information nor does it include the second information”. A similar change is recommended to the Applicants.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 31-41 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

12. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

13. In this particular case, the process recited in independent claim 31 does not tie to another class (such as a computer, or even the apparatus mentioned in earlier claims), nor does it transform any underlying subject matter to a different state. Claims 32-41 are rejected at least as being dependent upon independent claim 31.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 22-26, 30-36, and 40-42 rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent 5,974,150 (“Kaish”).

16. As claims 22-26, 30-36, and 40-42 are best understood by the Examiner, Kaish teaches:

- b. input unit configured to input product data (figure 2, reference numbers 20, 35-39, 41; figure 3, reference numbers 43, 44, 45; column 25, line 50 – column 26, line 14);
- c. determining unit configured to determine that a product is a genuine product when the unit determines that the data includes first information and second information (column 9, lines 12-22; column 10, line 57 – column 11, line 2);

- d. determining that the product is a counterfeit product when the unit determines that the data includes first information and not second information (Abstract; column 1, lines 22-25; column 9, lines 3-10);
- e. determining that the product is neither genuine nor counterfeit when the unit determines that the data does not include the first information and the second information (Abstract; figures 4a, 4b; column 25, line 50 – column 26, line 14);
- f. information includes image information, registered trademark (figure 1, reference numbers 3, 5, 6, 7);
- g. image unique to a genuine product (figure 1, reference numbers 3, 4, 8, 9, 10);
- h. storing determination result (figure 2, reference numbers 20, 24; figure 3, reference numbers 45, 48, 55; figure 4a, reference numbers 106, 107);
- i. product includes toner for a printer (the Examiner contends that this is an intended use of the invention, as such, it is not given patentable weight. Furthermore, there is nothing preventing the system in Kaish from being used as a printer toner counterfeit detection system, instead noting that “electronics and software products are also particular targets of counterfeiters” (column 1, lines 53-56));
- j. non-genuine and non-counterfeit product includes a third-party product (assuming that products containing the data described in Kaish are genuine, and products containing only part of the code are counterfeit, then products not containing identifying marks nor the identification verification marks would inherently be third-party products).

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 27-30 and 37-40 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish in view of Official Notice.

19. As claims 27-30 and 37-40 are best understood by the Examiner, Kaish teaches:

k. information is written in a micro-character (see Figure 1, reference numbers 8, 10.

Kaish does not explicitly disclose using a micro-character to further the security of the system. The Examiner takes Official Notice that using micro-characters for providing a higher lever of visual security was well known to those skilled in the art at the time of the invention. These characters were well known to those skilled in the art at the time of the invention to provide an easily-authenticated system of physical objects. Due to the desire to easily authenticate items using micro-characters being well known to those skilled in the art at the time of the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use micro-characters in conjunction with the system in Kaish, to give a higher degree of security. A person having ordinary skill in the art would understand that the usage of micro-characters would be advantageous, since it provides for a more easily-authenticated system that is harder to forge. The Examiner further notes that Applicant did not challenge Examiner's original assertion of the well-known property of this limitation, and is hereby admitted as prior art);

l. configured to notify another terminal of a determination result obtained by the determining unit (see column 25, lines 42-49. Kaish does not explicitly disclose that the user information is transmitted to the remote site. There is a desire in the system in Kaish to provide a secure method of authenticating products – evidence exists in column 26, lines 33 – 36. Clearly there is a desire for security, and sending along the authenticated user information would allow for a higher degree of security in the system. Additionally, it was obvious to one skilled in the art at the time of the invention to send usernames with secure communication, in order to authenticate transactions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the user information to the remote site, in order to provide a higher level of security. A person having ordinary skill in the art would understand this to be advantageous, as it provides more security. The Examiner further notes that Applicant did not challenge Examiner's original assertion of the well-known property of this limitation, and is hereby admitted as prior art);

m. when the unit determines that a product is a counterfeit product, the unit notifies a counterfeit product's regulatory authority terminal of the determination result (Kaish does not explicitly teach that a regulatory authority terminal receives notification of the determination result. The Examiner takes Official Notice that notifying a regulatory authority of counterfeit products was old and well-known in the art because this is how most regulatory authorities receive information on such products, by self-reporting of individuals receiving counterfeit items);

n. product includes toner for a printer (It is the examiner's primary position that the claims are anticipated because of the inherent feature (i.e. using the invention in Kaish to identify printer toner). However, if not inherent, then the Examiner takes Official Notice that anti-counterfeiting equipment and methods were old and well-known in the art of printer toner manufacturing. Numerous manufacturers have implemented anti-counterfeiting measures for printer supplies. This is done to prevent counterfeit printer toner from undercutting manufacturers' sales and adversely affecting the printers they are used on. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Kaish on printer toner, as it would create a more powerful and profitable situation for the printer toner manufacturer, something that a person having ordinary skill in the art would understand as being advantageous).

Response to Arguments

20. No arguments were filed with the response of 9 March 2008.
21. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.
22. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well.

It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher C Johns
Examiner
Art Unit 3621

CCJ

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685